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PATENT LAW GROUP LLP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE, CA 95134

EXAMINER

ONEILL, MICHAEL W

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,460

Applicant(s)

GAUSELMANN, MICHAEL

Examiner

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-39 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-39 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 12-13, 15-16, 19, 24-28, 34, 36-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Patent No. 6,439,993) in view of Bennett (US Patent No. 6,089,977).

Regarding claim 1 et seq.: O'Halloran discloses a gaming method wherein a selected combination of symbols in a matrix of M rows and N columns is displayed (FIG 1) wherein the selected symbols include at least one special symbol and other symbols (Column 1, lines 38-43). The method also comprises converting at least one of said other symbols to at least one different symbol due the at least one special symbol being selected for the matrix (Column 1, lines 38-43). What O'Halloran lacks in apparently disclosing is the special symbol converting at least one of said other symbols to at least one differnt symbol, different from said special symbol due to said special symbol being slected for said matrix. In an analogous gaming device, Bennett teaches having a special symbol, iceberg, showing up on the matrix causing the penguin feature symbol to change other symbols on the matrix to a different symbol, a penguin, different from the special symbol, the iceberg. See col. 3:8

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through col. 5:52. The reason Bennett provides this feature is suggested in col. 1:38-40 where Bennett states "gaming machine manufacturers are keen to devise game which are popular with players, as a mechanism for improving sales." Therefore, it would have been obvious to one of ordinary skill in the art to apply the teachings of Bennett into the O'Halloran gaming machine in order to fulfill the suggest found in Bennett of gaming machine manufacturers are keen to devise game which are popular with players, as a mechanism for improving sales." And solving a problem stated in O'Halloran of "known gambling machines lack variety and players lose interest, in particular, after repeated plays." See col. 1:20-22. Thus, the combination of the two concepts would provide a solution to the problem recited above within the primary reference O'Halloran.

Regarding claim 2, the gaming method includes displaying the matrix to the user (see FIGs 1-3).

Regarding claim 3, the conversion of display symbols in the matrix to different symbols occurs due to the special symbol being selected (Column 1, lines 38-43).

Regarding claim 4, the selection occurs based on a psuedo-random number generation (Column 5, lines 40-45).

Regarding claim 5, an award is provided for certain combination of symbols across one or more paylines (Column 1, lines 5-15).

Regarding claim 6, the number of rows is three and the number of columns is 5 (see FIGs 1-3).

Regarding claims 12, the conversion comprises converting certain other symbols to the special symbol (Column 3, lines 5-10).

Regarding claim 13, the conversion includes the initially selected symbols being changed to a converted symbol (Column 2, lines 63-64).

Regarding claim 15, the method further determines after conversion whether the symbol is a winning combination (Column 1, lines 40-44).

Regarding claim 16, the paylines are disclosed to be horizontal (Column 1, lines 34-37).

Regarding claim 24, O'Halloran discloses a display device with control circuitry. As for the intended use of such a device, the control also controls the display to display a combination of selected symbols in an M x N matrix (FIG 1) wherein the symbols include at least one special symbol and other symbols (Column 1, lines 38-43) to control the display to

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convert at least one other symbols to a different symbol due to the special symbol occurring (Column 1, lines 38-43).

Regarding claim 25, O'Halloran also discloses the intended usage of converting displayed symbols to other symbols based on the special symbol occurring (Column 1, lines 38-43).

Regarding claim 26, the selection occurs based on a psuedo random number generation (Column 5, lines 40-45).

Regarding claim 27, an award is provided for certain combination of symbols across one or more paylines (Column 1, lines 5-15).

Regarding claim 28, the number of rows is three and the number of columns is 5 (see FIGs 1-3).

Regarding claim 34, the conversion comprises converting certain other symbols to the special symbol (Column 3, lines 5-10).

Regarding claim 36, the method further determines after conversion whether the symbol is a winning combination (Column 1, lines 40-44).

Regarding claim 37, the paylines are disclosed to be horizontal (Column 1, lines 34-37).

Claims 7-11, 14, 18, 20-23, 29-33, 35, 39 and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran in view of Bennett.

What O'Halloran and Bennett disclose regarding certain claim limitations has been discussed above and is incorporated herein.

O'Halloran discloses in one embodiment that when the special symbol occurs, the substitution can occur on adjacent reels so as to be contiguous on a win line (Column 1, lines 48-51). O'Halloran also discloses that other variations and modification are within the scope of the invention including alternates or changes to steps disclosed therein. Hence, from the disclosure of O'Halloran a skilled artisan would find it obvious to convert symbols that are adjoining, to the left, to the right or randomly into the special symbol. One of ordinary skill in the art would thus find it obvious based upon the disclosure of O'Halloran to allow for a different pattern of symbols to be changed than those adjacent. One would be motivated to do so based upon the disclosure of O'Halloran that other variations are obvious as well as the fact that allowing different symbols to change based on different positions, the game would become more interesting as one would not be able to predict which symbols would be changed. O'Halloran even

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addresses this motivation in stating that if gambling machines lack variety, players will lose interest (Column 1, lines 20-22) thus a skilled artisan would be strongly motivated to follow this advice as well as the various embodiments dictated as obvious to allow for the special symbol to convert symbols in different places thus creating a game of variety that would not bore players.

Regarding claims 8, 10, 21-22, 30, 32, 42-44 O'Halloran discloses that the special symbol changes the other symbols into a wild card; however, for the reasons disclosed above regarding the additional disclosure of O'Halloran, one of ordinary skill in the art would find it obvious to allow the symbols to be changed to that defined by the programmer or player in order to keep the interest of the players and keep them guessing as to where and how the change will occur. One would be motivated to do this in order to adhere to the O'Halloran teachings of adding variety as well as to adhere to the specific design requirements for their system wherein the programmer would choose the method of change based on their wants, needs, and desires for their system.

Regarding claims 14 and 35, O'Halloran discloses the special symbol to be a wild card but does not go into detail as to what it represents. However, an art rule is that when a wild

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card occurs, it will represent the symbol, which will give the player the highest payout for a line, thus representative of the symbol with the highest value. Thus, this representation would be obvious when the wild card is used in order to attract and maintain players and adhere to the standard industry rules.

Claims 17 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Patent No. 6,439,993) in view of Bennett (US Patent No. 6,089,977) in view of Mayeroff (US Patent No. 6,224,483).

What O'Halloran and Bennett disclose, teach, and/or suggest have been discussed above and is incorporated herein.

O'Halloran discloses multiple paylines but does not disclose the payline being bent.

Mayeroff discloses that a popular payline format on a 3x5 slot is the Australian style, which comprises nine different paylines, including bent ones (Columns 1 and 2). Mayeroff further discloses that a plethora of winning symbol combinations is provided so that the player has a large number of various opportunities to win (Column 3, lines 9-12). It would have been obvious to one of ordinary skill in the art to use a bent payline configuration in the O'Halloran machine in order to provide the player with more betting opportunities, thus increasing their excitement and anticipation. Further, the

usage of one payline over another is a design choice, obvious to one of ordinary skill in the art, and motivated by the wants and needs for a system as defined by its designer.

Response to Arguments

Applicant's arguments filed 12-27-2004 have been fully considered but they are not persuasive. Respectfully, Applicant needs to more particularly define the invention within the claims. Just inserting an amendment to avoid an anticipatory rejection is not particularly defining the invention. All said amendments do is stall prosecution. This Applicant is well verse in the art and should know better. Furthermore, it is the instant Examiner's position that if a claim only has two method steps and it is opened end, then all the prior art of record needs to disclose, teach or suggest is those two steps and it does not matter that other steps or processes are in between those two steps because the claim is open-ended with the term "comprising" being used.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

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reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "m O'Neill", written in a cursive style.

**MICHAEL O'NEILL
PRIMARY EXAMINER**